

Attorney Docket No. P28025

Application No. 10/538,772

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Atsushi MIYAWAKI et al.

Confirmation No. 6795

Group art Unit: 1653

Appln. No. : 10/538,772
(National Stage of PCT/JP2003/015790)

Examiner: Jae W. LEE

I.A. Filed : June 10, 2005

For : FLUORESCENT INDICATOR USING FRET

ELECTION WITH TRAVERSE

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Amendment
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

This is in response to the requirement for restriction under 35 U.S.C. § 121 and § 372 mailed from the U.S. Patent and Trademark Office on February 28, 2007, which sets a 30-day shortened statutory period for response, until March 30, 2007. Applicants hereby request an extension of time for two months and are concurrently filing a formal Request for Two-Month Extension of Time, together with all requisite fees therefore. If for any reason the Request for Extension of Time is not associated with the file, or the fee submitted herewith is deemed insufficient for any reason, the present submission should be interpreted to include the requisite Request for Extension of Time, and the Patent and Trademark Office is hereby authorized to charge any necessary fee to Deposit Account No. 19-0089.

RESTRICTION REQUIREMENT

The Examiner has required restriction under 35 U.S.C. 121 and 372 to one of the following inventions:

- I) Claims 1-15, drawn to a fluorescent indicator.
- II) Claims 16-20, drawn to a method for detecting or measuring an analytical substance in a sample.
- III) Claims 21-23, drawn to a nucleic acid encoding the fluorescent indicator, an expression vector and a transformant.

ELECTION

In order to be responsive to the requirement for restriction, Applicants elect, with traverse, the invention set forth in Group III, **claims 21 – 23**. Further, Applicants elect, with traverse, **calmodulin** as target sequence, **skeletal muscle myosin light chain kinase (skMLCKp)** as target peptide component, and **nucleus-localized sequence** as localized sequence.

TRAVERSE

Notwithstanding the election of the claims of Group III and the species **calmodulin** as target sequence, **skeletal muscle myosin light chain kinase (skMLCKp)** as target peptide component, and **nucleus-localized sequence** as localized sequence, in order to be responsive to the requirement for restriction, Applicants respectfully traverse the requirement.

Applicants' traversal is based upon the fact that the Restriction Requirement fails to satisfy the requirements for supporting a restriction requirement under the PCT Rules. PCT

Rules 13.1 and 13.2 state that an international application must relate to one invention only or, if there is more than one invention, those inventions must be so linked as to form a single general inventive concept (Rule 13.1). Inventions are considered linked so as to form a single general inventive concept only when there is a technical relationship involving one or more of the same or corresponding “special technical features.” The expression “special technical features” means those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art (Rule 13.2).

Additionally, Applicants respectfully note that Annex B to the PCT Rules states:

(c) Independent and Dependent Claims. Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By “dependent” claim is meant a claim which contains all the features of another claim and is in the same category of claim as that other claim (the expression “category of claim” referring to the classification of claims according to the subject matter of the invention claimed for example, product, process, use or apparatus or means, etc.).


Applicants respectfully note that the Office requires a selection within Groups I – III; however, the claims of Group II and Group III are dependent claims of claims relating to Group I. Additionally, Applicants note that the Office requires an election of species, wherein the species are recited in dependent claims 7, 9, and 15. Applicants wish to emphasize that the Annex to the PCT Rules specifically advises that *dependent* claims cannot be considered for unity of invention purposes. Accordingly, for the above reason alone, the Restriction Requirement is improper and should be withdrawn.

Additionally, Applicants respectfully note that the Examiner’s conclusions relating to a lack of unity of invention are based entirely upon a finding that the claimed subject matter is found in the prior art. Accordingly, Applicants respectfully submit that the Office will be required to withdraw the Restriction Requirement upon reciting subject matter that is not disclosed in the prior art. Still further, Applicants respectfully reserve the right to rebut any

statements that the Office has made relating to the disclosure of the present invention in the prior art.

If there are any comments or questions, the undersigned may be contacted at the below-listed telephone number.

Respectfully submitted,
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